

Remarks

Claim 1, as amended, is now pending.

Claim 1 has been amended in order to more clearly present the tire tread as being configured with tread lugs where *both* the tread and tread lugs are of the closed cellular rubber composition and where the rubber of the rubber composition is more clearly presented as being comprised of at least one isobutylene copolymer.

The Rejection

The following patents and patent applications have been relied upon to reject various of the Applicants' claims:

U.S. Patents

4,249,588	Egan
4,487,892	Ohmori et al. (Ohmori)

U.S. Patents Applications

2003/0089438	Sandstrom et al. (Sandstrom)
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Foreign Patents

WO 02/40581	Cole
JP 8-324209	Japan 209
SU 1625713	Russia

Rejections Under 35 U.S.C. Section 112, Second Paragraph

It is believed that the Examiner's objections to the Applicants' claims have been remedied by the cancellation of various of the Applicants' claims.

Rejections Under 35 U.S.C. Section 103

Claims 1 and 5 through 12 have been rejected under 35 U.S.C. Section 103(a) as being obvious over Sandstrom in view of Cole and Egan and optionally Japan 209. Claims 5 through 12 have been cancelled so that only amended claim1 remains.

A reconsideration of the rejections of the Applicants' claims under 35 U.S.C. Section 103(a) is requested in view of amendments made to the claims and comments herein.

The Invention

It is important to appreciate that it is intended that the tread, including its tread lugs, composed of a diene-based elastomer(s) are comprised of the closed cellular rubber composition and that the rubber of the rubber composition is comprised of an isobutylene copolymer.

In this manner, then, a cushioning effect is provided which extends through the tread lugs and thence through the tread to the tire carcass.

Discussion

The cited Sandstrom reference is directed to an agricultural tire with tread of a shock absorbing butyl rubber composition without any teaching or suggestion to use the Applicants' required closed cellular rubber composition for its agricultural tire tread to create a cushioning effect extending through the tread lugs and thence through the tread in addition to the aforesaid shock absorbing effect of Sandstrom for its butyl rubber based agricultural tread.

It is intended, then, that the Applicants' amended claim 1 excludes the agricultural tire of Sandstrom.

Accordingly, it is contended seen that Sandstrom, by itself, is materially deficient for a purpose of rejecting the Applicants' amended claims as being obvious in the sense of 35 U.S.C. Section 103(a), particularly since there is nothing in the Sandstrom to lead one to use a closed foam rubber for an agricultural tire tread without a significant reconstruction of the Sandstrom reference itself.

The cited Cole reference relates to a tire, such as a bicycle tire, which contains an "outer tire layer" of microcellular closed-cell sponge rubber created various blowing agents. However, Cole is not related to a tire of the Applicants' required type, namely a tire tread having significantly spaced apart and significantly raised lugs which themselves required to

be composed of a closed cellular structured rubber of defined cellular density and cell size.

It would not be obvious to one having ordinary skill in the tire art to use the “outer tire layer” of Cole of a microcellular closed cell sponge rubber created with the Cole-indicated blowing agent(s) for the significantly lugged rubber tread of Sandstrom to arrive at the Applicants’ claimed invention in the absence of the Applicants’ own specification and claims without undue experimentation. It is contended that, at most, the disclosure of Cole amounts to no more than an invitation to try the microcellular closed sponge rubber of Cole in the lugged tread of Sandstrom.

Accordingly, it is contended that Cole is materially deficient and does not correct the aforesaid deficiency of Sandstrom for rejecting the Applicants’ amended claim 1 as being obvious in the sense of 35 U.S.C. Section 103(a). It is contended that the combination of Sandstrom and Cole does not make out a prima facie case of obviousness of the Applicants’ claimed invention in the sense of 35 U.S.C. Section 103(a).

The Egan reference is apparently cited to show use of various blowing agents to create closed cellular rubber compositions for a tire tread apparently without any teaching or suggestion of an agricultural tire tread with significant raised lugs of comprised of an isobutylene copolymer based elastomer.

Accordingly, it is believed that a combination of Sandstrom with any of the Cole and Egan references do not make out a prima facie case of obviousness of the Applicants’ claimed invention in the sense of 35 U.S.C. Section 103(a). It is believed to be well understood that an appropriate test under 35 U.S.C. Section 103(a) is not whether something could be done but whether something was in fact done or was taught to be done. Here, it should not be an inquiry of whether the closed cellular rubber of Cole or Egan could have been used for the butyl rubber tread of Sandstrom or the isobutylene copolymer based rubber agricultural tire tread of the Applicants’ amended claim 1, but more appropriately whether it

was taught or suggested to anyone to use such closed cellular rubber for the tread of the Applicants' claimed agricultural tire.

The tire of Japan 209 is limited to presenting a layer on the outside of the tread lugs to act as a mud anti-sticking layer with no teaching or suggestion to provide an entire tread and lugs with a closed cellular rubber composition to provide the Applicants' required damping effect to extend entirely through the tread lugs and thence through the tread. According, it is intended that the invention of the Applicants' amended claim 1 excludes the tire of Japan 209 which is limited to a tire tread with only a thin closed cell outer layer.

It is therefore contended that tire of the Japan 209 reference is materially deficient for a purpose of rejecting the Applicants' amended claim 1 without its significant reconstruction and that the invention of the Applicants' amended claim 1 is not obvious in view of Japan 209 in the sense of 35 U.S.C. Section 103(a).

Again, it is important to appreciate that the issue should not be whether one *could possibly* expand the closed cellular rubber layer of Japan 209 to include an entire tread and lugs, but, instead, whether there is any teaching or suggestion or even a vision or motivation within Japan 209 for one to make such an expansion. It appears that, insofar as Japan 209 is concerned, it is clearly only the Applicants' disclosure and claims which teach the invention of the Applicants' amended claim 1.

Accordingly, it is contended that a prima facie case of obviousness of the invention of the Applicants' amended claim 1 is not made out by any combination of Sandstrom, Cole, Egan and Japan 209 in the sense of 35 U.S.C. Section 103(a).

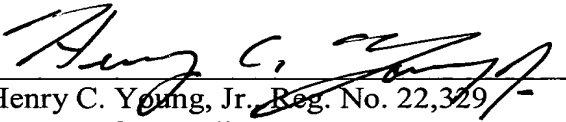
It is not entirely clear as to how the previously cited Ohmori publication (relating to a rubber composition for tires comprised of non-crystallizable resinous copolymers of alpha methyl styrene or styrene containing a diene and specified rubbers with no teaching or suggestion of a tire tread of a closed cellular rubber) and/or the previously cited

Russia publication (which discusses a tire having a tread with a protective coating on its outer surface having good gas impermeability without any teaching or suggestion of a tire composed of a closed cellular rubber), if combined with any of Sandstrom, Cole, Egan and Japan 209, would be applied to reject the Applicants' amended claim 1 as being obvious in the sense of 35 U.S.C. Section 103(a).

Conclusion

It is contended that the invention of the Applicants' amended claim 1 is patentably distinct from the applied references, whether applied singularly or in any combination and that a prima facie case of obviousness of the invention of the Applicants' amended claim 1 is not made out by any individual or combination of the applied references in the sense of 35 U.S.C Section 103(a).

Respectfully submitted,


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